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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,413	03/30/2001	Mark E. Lundegren	85ER-00114	3205
7590 10/11/2005 Armstrong Teasdale LLP One Metropolitan Square St Louis, MO 63102			EXAMINER PORTER, RACHEL L	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/681,413

Applicant(s)

LUNDEGREN, MARK E.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2001 and 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 37-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS's) submitted on 6/1/01, 6/3/02 and 7/18/02 have been entered and considered by the examiner.

Notice to Applicant

2. Claims 1-47 are pending. Claims 37-47 have been withdrawn from consideration, as per applicant's response to the restriction requirement mailed 7/14/2005. Claims 1-36 will be considered on the merits.

Election/Restrictions

3. Applicant's election with traverse of Group I in the reply filed on 7/14/05 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner to examine both groups and that both groups are related. This is not found persuasive because the Examiner has not asserted that the subcombinations are unrelated. In fact the restriction requirement states that the two inventions are in fact related. However, the detail and claim language of the subject matter found in the two inventions require separate classifications and divergent searches. Because these inventions have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, the requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4,6,9-14,16,19-21,23,26-29,31, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Erlanger (USPAP 2003/02001125).

[claim 1] Erlanger discloses a method of coordinating, by a sponsor, an auction for providing reinsurance for an insurance program of a cedent by a plurality of reinsurers, comprising the steps of:

- establishing a network of participating reinsurers meeting eligibility requirements to participate in said auction; (Figure 5—312, par. 178)
- establishing a reinsurance capacity for each of said participating reinsurers; (par. 181-189)
- receiving a request for reinsurance of an insurance program from a cedent; (par. 192)
- performing an underwriting analysis of said request for reinsurance and producing an underwriting report including an analysis of risk of loss associated with said insurance program; (par. 183-189)

- making said request for reinsurance and said underwriting report available to said participating reinsurers and enabling said participating reinsurers to make respective bids, during a selected period, to reinsure a portion of said insurance program; (par. 191-192) each bid to include a maximum percentage of reinsurance for said insurance program offered by said participating reinsurer and a rate specified by said participating reinsurer; (par. 193-195)
- receiving bids from said participating reinsurers during said selection period; (par. 192)
- selecting bids which fulfill said request for reinsurance, as a reinsurance proposal; and (par. 198)
- offering said reinsurance proposal to said cedent. (par. 198-199)

[claim 2] Erlanger discloses the method as in claim 1 wherein said step of selecting bids for said reinsurance proposal comprises optimizing the bids selected to minimize the cost of said reinsurance proposal to said cedent. (par. 177,181,192—the fees generated by the system help insurers costs down)

[claim 3] Erlanger discloses a method further comprising the step of notifying said participating reinsurers that said sponsor will provide a portion of said reinsurance at a price and percentage to be determined by said sponsor prior to selecting bids for said reinsurance proposal. (par.166-172: a portion of the fees of data system (i.e. sponsor) are remitted to the insurer/reinsurer and thus provide a portion of insurance/reinsurance)

[claim 4] Erlanger discloses a method further comprising the steps of binding said selected participating reinsurers to provide reinsurance for said insurance program; and guaranteeing, by said sponsor, payment by each of said selected participating reinsurers for any proper claims made for reinsurance of said insurance program. (par. 91, 125, and 134—binding insurers/reinsurers to contractual obligations and the provision of insurance services)

[claim 6] Erlanger discloses a method further comprising the step of adjusting said rate of each bid to include a service charge to be paid by said cedent and collected by said sponsor. (par. 128, 134)

[claim 9] Erlanger discloses a method wherein said reinsurance comprises an agreement to pay claims obligations under an existing insurance program. (par. 37, par. 49)

[claim 10] Erlanger discloses a further comprising the step of determining whether said request for reinsurance meets minimum eligibility requirements for submission of said request to said network of participating reinsurers. (par. 84; 113-116)

[claim 11] Erlanger discloses a method of coordinating, by a sponsor, an auction for providing insurance for a cedent by a plurality of insurers, comprising the steps of:

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- establishing a network of participating insurers meeting eligibility requirements to participate in said auction; (figure 4—step 301)
- establishing an insurance capacity for each of said participating insurers; (Fig. 4 step –302, par. 84)
- receiving a request for insurance from a cedent; (par. 91-92)
- performing an underwriting analysis of said request for insurance and producing an underwriting report including an analysis of risk of loss associated with said insurance; (par. 79-81)
- making said request for insurance and said underwriting report available to said participating insurers and enabling said participating insurers to make respective bids, during a selected period, to cover a portion of said insurance; (par. 91-93; par. 178-179) each bid to include a maximum percentage of insurance offered by said participating insurer and a rate specified by said participating insurer; (par. 181-189)
- receiving bids from said participating insurers during said selected period; (par. 192)
- selecting bids which fulfill said request for insurance, as an insurance proposal; and (par. 198, Figure 5)
- offering said insurance proposal to said cedent.(par. 199)

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[claim 12] Erlanger teaches a wherein said step of selecting bids for said insurance proposal comprises optimizing the bids selected to minimize the cost of said insurance proposal to said cedent. (par. 91, 125—binding insurers/reinsurers)

[claim 13] Erlanger teaches a method further comprising the step of notifying said participating insurers that said sponsor will provide a portion of said insurance at a rate and percentage to be determined by said sponsor prior to selecting bids for said insurance proposal. (par.166-172: a portion of the fees of data system (i.e. sponsor) are remitted to the insurer/reinsurer and thus provide a portion of insurance/reinsurance)

[claim 14] Erlanger teaches a method further comprising the steps of binding said selected participating insurers to provide said insurance; and guaranteeing, by said sponsor, payment by each of said selected participating insurers for any proper claims made on said insurance. (par. 91, 125, and 134—binding insurers/reinsurers to contractual obligations and the provision of insurance services)

[claim 16] Erlanger teaches a method further comprising the step of adjusting said rate of each bid to include a service charge to be paid by said cedent and collected by said sponsor. (par. 128, 134)

[claim 19] Erlanger teaches a method wherein said insurance comprises an agreement to pay claims obligations under an existing insurance agreement. (par. 37, par. 49)

[claim 20] Erlanger teaches a method further comprising the step of determining whether said request for insurance meets minimum eligibility requirements for submission of said request to said network of participating insurers. (par. 84; 113-116)

[claim 21] Erlanger teaches a process for coordinating, by a sponsor, an auction for providing insurance for a cedent by a plurality of insurers comprising the steps of:

- establishing a network of participating insurers meeting eligibility requirements to participate in said auction; (figure 4—step 301)
- establishing an insurance capacity for each of said participating insurers; (Fig. 4 step —302, par. 84)
- receiving a request for insurance from a cedent; (par. 91-92)
- making said request for insurance available to said participating insurers and enabling said participating insurers to make respective bids, during a selected period, to cover a portion of said insurance; (par. 91-93; par. 178-179)
 - o each bid to include a maximum percentage of insurance offered by said participating insurer and a rate specified by said participating insurer; (par. 181-189)
- receiving bids from said participating insurers during said selection period; (par. 192)
- selecting bids which fulfill said request for insurance, as an insurance proposal; (par. 198, Figure 5)

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- offering said insurance proposal to said cedent; (par. 199)
- binding said selected participating insurers to provide said insurance; and guaranteeing, by said sponsor, payment by each of said selected participating insurers for any proper claims made on said insurance. (par. 91, 125, and 134—binding insurers/reinsurers to contractual obligations and the provision of insurance services)

[claim 23] Erlanger discloses a method as further comprising the step of adjusting said rate of each bid to include a service charge to be paid by said cedent and collected by said sponsor. (par. 128, 134)

[claim 26] Erlanger teaches a method wherein said step of selecting bids for said insurance proposal comprises optimizing the bids selected to minimize the cost of said insurance proposal to said cedent. (par. 91, 125—binding insurers/reinsurers)

[claim 27] Erlanger teaches a method further comprising the step of notifying said participating insurers that said sponsor will provide a portion of said insurance at a rate and percentage to be determined by said sponsor prior to selecting bids for said insurance proposal. (par. 166-172: a portion of the fees of data system (i.e. sponsor) are remitted to the insurer/reinsurer and thus provide a portion of insurance/reinsurance)

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[claim 28] Erlanger discloses a method wherein said insurance comprises an agreement to pay claims obligations under an existing insurance agreement. (par. 37, par. 49)

[claim 29] Erlanger teaches a process for coordinating, by a sponsor, an auction for providing reinsurance for a cedent by a plurality of insurers comprising the steps of:

- establishing a network of participating reinsurers meeting eligibility requirements to participate in said auction; (Figure 5—312, par. 178)
- establishing a reinsurance capacity for each of said participating reinsurers; (par. 181-189)
- receiving a request for reinsurance from a cedent; (par. 192)
- making said request for reinsurance available to said participating reinsurers and enabling said participating reinsurers to make respective bids, during a selected period, to cover a portion of said reinsurance; (par. 191-192)
 - o each bid to include a maximum percentage of reinsurance offered by said participating reinsurer and a rate specified by said participating reinsurer;
- receiving bids from said participating reinsurers during said selected period; (par. 193-195)
- selecting bids which fulfill said request for reinsurance, as a reinsurance proposal; (par. 198)
- offering said reinsurance proposal to said cedent; (par. 198-199)

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- binding said selected participating reinsurers to provide said reinsurance; and guaranteeing, by said sponsor, payment by each of said selected participating reinsurers for any proper claims made on said reinsurance. (par. 91, 125, and 134—binding insurers/reinsurers to contractual obligations and the provision of insurance services)

[claim 31] Erlanger teaches a method further comprising the step of adjusting said rate of each bid to include a service charge to be paid by said cedent and collected by said sponsor. (par. 128, 134)

[claim 34] Erlanger teaches a method wherein said step of selecting bids for said reinsurance proposal comprises optimizing the bids selected to minimize the cost of said reinsurance proposal to said cedent. (par. 91, 125—binding insurers/reinsurers)

[claim 35] Erlanger teaches a method further comprising the step of notifying said participating reinsurers that said sponsor will provide a portion of said reinsurance at a rate and percentage to be determined by said sponsor prior to selecting bids for said reinsurance proposal. (par. 166-172: a portion of the fees of data system (i.e. sponsor) are remitted to the insurer/reinsurer and thus provide a portion of insurance/reinsurance)

[claim 36] Erlanger teaches a method wherein said reinsurance comprises an agreement to pay claims obligations under an existing reinsurance agreement. (par. 37, par. 49)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 18, 25, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlanger in view of Official Notice.

[claim 8] Erlanger discloses the method of claim 1 as explained in the rejection of claim 1, but does not expressly disclose a method further comprising, after said step of selecting bids for said reinsurance proposal, the step of allowing a cedent to adjust a percentage of participation of selected and non-selected participating reinsurers within each participating reinsurer's capacity. However, it is respectfully submitted that the use of use of "counteroffers" in a negotiation process is old and well-known in the art. At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Erlanger to allow the insurance seeker (e.g. cedant) to adjust the percentage of participation in the bidder's proposal within each bidder's range (i.e. reinsurer's capacity). One would have been motivated to include this feature to

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facilitate the selection process among proposals that may otherwise be equally competitive.

[claim 18] The limitations of claim 18 are substantially similar to claim 8, and are addressed by the rejection of claims 8 and 11.

[claim 25] The limitations of claim 25 are substantially similar to claim 8, and are addressed by the rejection of claims 8 and 21.

[claim 33] The limitations of claim 33 are substantially similar to claim 8, and are addressed by the rejection of claims 8 and 29.

8. Claims 5,7,15,17,22,24,30, and 32 and rejected under 35 U.S.C. 103(a) as being unpatentable over Erlanger in view of Walker et al (USPN 6,119,093).

[claim 5] Erlanger discloses a method for coordinating the auction of insurance through a sponsor as disclosed in the rejection of claim 4, but does not expressly disclose that the method further comprises adjusting bids for credit risk and collecting a credit risk charge against the insuring entity against a possible default. Walker discloses a system/method in which a line of credit and verification of a credit line is determined for bidding investors in an insurance syndication system. This credit line may be frozen for a period of time pending any transaction for the syndicated insurance

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policy (col. 5, lines 9-28—e.g. securing a credit risk charge). At the time of the Applicant invention, it would have been obvious to one of ordinary skill in the art to modify the method of Erlanger with the teaching of Walker to secure a credit risk charge to protect against defaults from insuring “investing”/bidding parties. As suggested by Walker, one would have been motivated include this feature to add a measure of financial security to the transaction and offset a portion of the risk. (col. 1, lines 25-52)

[claim 7] Erlanger teaches a method of coordinating members of an insurance auction and further discloses binding said selected participating reinsurers/ insurers to provide reinsurance for said insurance program; (par. 91, 125, and 134—binding insurers/reinsurers to contractual obligations and the provision of insurance services). Erlanger does not disclose:

- collecting premiums from said cedent for said reinsurance and distributing to each of said selected participating reinsurers its share of the premiums collected; and
- processing claims made against said reinsurance, including notifying each said selected participating reinsurers of claims due under said reinsurance, collecting claims payments from each of said selected participating reinsurers, and distributing said claims payments to said cedent.

Walker discloses a method further comprising collecting premiums from the insured and distributing them to the insuring entity/-ies (Figure 13) and processing claims under the insurance (e.g. reinsurance policy) (Figure 14). At the time of the Applicants invention,

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it would have been obvious to one of ordinary skill in the art to modify the method of Erlanger with the teaching of Walker. As suggested by Walker, one would have been motivated to include these features to offer a method by which small insurance syndicates can be more easily created and managed for smaller investors (col. 2, lines 40-44)

[claim 15] The limitations of claim 15 are substantially similar to claim 5 and are addressed by the rejections of claims 5 and 14.

[claim 17] The limitations of claim 17 are substantially similar to claim 7 and are addressed by the rejections of claims 7 and 11.

[claim 22] The limitations of claim 22 are substantially similar to claim 5 and are addressed by the rejections of claims 5 and 21.

[claim 24] The limitations of claim 24 are substantially similar to claim 7 and are addressed by the rejections of claims 7 and 21.

[claim 30] The limitations of claim 30 are substantially similar to claim 5 and are addressed by the rejections of claims 5 and 29.

[claim 32] The limitations of claim 32 are substantially similar to claim 7 and are addressed by the rejections of claims 7 and 29.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RP

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER
